

REMARKS

Claims 1-4, 7-10, 13-17, 20, 21, and 43-47 were pending in this application.

Claims 1-4, 7-10, 13-17, 20, 21, and 43-47 have been rejected.

Claims 1-4, 7-10, 13-17, 20, 21, and 43-47 have been amended as shown above.

Claim 48 has been added.

Claims 1-4, 7-10, 13-17, 20, 21, and 43-48 are now pending in this application.

Reconsideration and full allowance of all pending claims are respectfully requested.

I. CLAIM REJECTION UNDER 35 U.S.C. § 102

Claims 1, 2, 4, 7, 8, 10, 13-17, 20, and 43-47 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,108,945 to Matthews (“*Matthews*”). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-76 (8th ed., rev. 4, October 2005) (*citing In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987)).

Claims 1 and 43 recite that an emitter of a double poly bipolar transistor and a source/drain of a double poly MOS transistor comprise a “second dopant” having a “second dopant concentration.”

In rejecting Claims 1 and 43 over *Matthews*, the Office Action asserts that *Matthews* discloses using arsenic to form the emitter of a bipolar transistor and boron to form the source/drain of a MOS transistor. (*Office Action, Page 3, First paragraph; Page 6, Section 6*). The Office Action also asserts that Claim 1 “only requires that the same ‘dopant’ is used with the same concentration” and that the “dopants in the emitter (67) and the source/drain (68/69) [in *Matthews*] are both n-type, and are therefore considered the same.” (*Office Action, Page 6, Section 6*).

This is legally improper and factually incorrect. Claims 1 and 43 do not recite that the same “type” of dopant is used in the emitter of a bipolar transistor and the source/drain of a MOS transistor. Claims 1 and 43 specifically recite that the same “dopant” is used in the emitter of a double poly bipolar transistor and the source/drain of a double poly MOS transistor. This cannot be anticipated by a reference that, as the Office Action acknowledges, specifically teaches using different dopants. Boron and arsenic are not the same dopant. Regardless of whether boron and arsenic are both n-type dopants, they are not the same dopant.

Any rejection under § 102 requires a showing that the cited reference discloses each and every element of Claims 1 and 43. That showing has not been made here. *Matthews* specifically recites the use of different dopants when forming the emitter of a bipolar transistor and the source/drain of a MOS transistor.

The Office Action also asserts that the “exact element used for the n-type dopant is not claimed” and that the “concentration of both n-type dopants are also disclosed to be the same.” (*Office Action, Page 6, Section 6*). However, the Applicants do not need to recite the specific

element forming the “second dopant” in Claims 1 and 43. Claims 1 and 43 already recite that the same “second dopant” is used in both the emitter of a double poly bipolar transistor and the source/drain of a double poly MOS transistor. In order to reject Claims 1 and 43 under § 102, the Office must therefore show that the same “dopant,” not the same “type of dopant,” is used in *Matthews*. The Office has not made and cannot make this showing.

For these reasons, *Matthews* fails to anticipate all elements recited in Claims 1 and 43 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1, 2, 4, 7, 8, 10, 13-17, 20, and 43-47.

II. CLAIM REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 3, 9, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Matthews* in view of U.S. Patent No. 5,091,760 to Maeda et al. (“*Maeda*”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP*

§ 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

Claims 3, 9, and 21 depend from Claim 1. As shown above, Claim 1 is patentable over *Matthews* since *Matthews* fails to disclose or suggest that the same “second dopant” is used in both the emitter of a double poly bipolar transistor and the source/drain of a double poly MOS transistor. *Maeda* fails to remedy this deficiency of *Matthews*.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claims 3, 9, and 21. Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 3, 9, and 21.

III. NEW CLAIM

The Applicants have added new Claim 48. The Applicants respectfully submit that no new matter has been added. At a minimum, the Applicants respectfully submit that Claim 48 is patentable for one or more reasons discussed above. The Applicants respectfully request entry and full allowance of Claim 48.

SUMMARY

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request full allowance of the claims.


If any issues arise or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckcarter.com*.

The Applicant has included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK CARTER, LLP

Date: Oct. 12, 2009



William A. Munck
Registration No. 39,308

P. O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *wmunck@munckcarter.com*